

### **Remarks**

This is in response to the Office Action dated April 30, 2008.

In response to the myriad obviousness-type double patenting rejections, being submitted with this Response is a Terminal Disclaimer for obviating these rejections in view of U.S. patents 7,254,103, 7,260,045 and 7,382,700 (cited in the Office Action as application 10/767,073); and in view of U.S. patent 5,301,040 in combination with each of the following: U.S. patents 6,980,501, 6,636,474, 6,810,003 and 7,006,422; and applications 10/648,476 and 10/648,481.

Claim 40 stands rejected under 35 U.S.C. 101.

In response to the Section 101 rejection, claim 40 has been amended to define the recording medium being usable at least by a decoding apparatus and/or a player, and that the use of the medium by a decoding apparatus is defined in the last paragraph starting with "wherein". With the amendments thereto, it is believed that the Section 101 rejection has been overcome.

Claims 40-43 stand rejected as being obvious over Heo et al. (US 5,987,417) in view of Hoshi et al. (US 5,301,040).

The Examiner alleges that Hoshi et al teach data representing the quantity of the bit shift (e.g. column 8, lines 1-14). Ignoring for the moment that column 8, lines 1-14 is part of recitations of claim 8, this portion of Hoshi et al indicates that a bit shift is performed on the quantized digital data to generate bit shifted quantized digital data, and then the bit shifted quantized digital data is encoded, and that second information regarding a number of bits of the bit shifted quantized digital data as encoded is outputted. It is submitted that a number of bits of the bit shifted quantized digital data as encoded differs from the

quantity of the bit shift. Accordingly, Hoshi et al do not teach data representing the quantity of the bit shift.

Hoshi et al, column 5, lines 50-53, show that the output of the quantization circuit 60 is shifted 0 to 3 bits. Therefore, in Hoshi et al, the quantity of the bit shift is 0 bit, 1 bit, 2 bits, or 3 bits. The bit shifted outputs of the quantization circuit 60 are applied to the respective VLCs 40a-40d followed by the coefficient calculator (see Fig. 2). The VLCs 40a-40d change the bit shifted outputs of the quantization circuit 60 into variable-length-code data Nb 1-Nb4, respectively (column 5, lines 52-63, and Fig. 2). Hoshi et al, column 5, lines 63-66, show that the amount of data Nb1-Nb4 represents the amount of data encoded by control coefficients C 1, C 1x2, C 1x4, and C1x8. The combination of the VLCs 40a-40d and the coefficient calculator operates to calculate the amount of data as encoded. Generally, the amount of data means the number of bits of data. Therefore, the combination of the VLCs 40a-40d and the coefficient calculator operates to calculate the number of bits of data as encoded. Accordingly, in Hoshi et al, the quantity of the bit shift absolutely differs from the number of bits of data as encoded. The second information in Hoshi et al, column 8, lines 1-14, corresponds to information generated by the combination of the VLCs 40a-40d and the coefficient calculator, and is regarding the number of bits of the bit shifted quantized digital data as encoded rather than the quantity of the bit shift.

That what is disclosed in column 8, lines 1-14 of Hoshi et al absolutely differs from the claimed feature is not surprising, insofar as column 8, lines 1-14 is part of claim 8 of Hoshi et al., and the examiner has erred in using the claim language in Hoshi et al for rejecting the claims. It is well established that the claims of a patent define the scope of the patent, but not what is disclosed in a patent. This is succinctly set forth by the CAFC in *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985) in which the court states: "The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding." 226 USPQ 686. See also *Minerals Separation North America v Magma Copper Co.*, 280 US 400, 402,

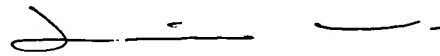
50 S. Ct 185, 186, 74 L. Ed 511 (1930). Thus, the use of claim language by the examiner for his rejection is simply wrong.

Each of independent claims (claims 40 and 41) has the limitation "the bit shift having a quantity common to the channels in the second channel group". Hoshi et al fail to teach this limitation in claim 40 or 41. Heo et al (US 5,987,417) also do not teach the limitation in claim 40 or 41.

Accordingly, claims 40-43 are patentable over Heo et al and Hoshi et al.

In view of the foregoing, the examiner is respectfully requested to reconsider the application and pass the same to issue at an early date.

Respectfully submitted,



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